

### REMARKS

Reconsideration and withdrawal of the rejection of all the claims now in the application (i.e. Claims 1, 2, 5, 7-27) is respectfully requested in view of the following remarks.

The Examiner rejected claims 1, 2, 5, 7, 10-12 and 14-17 as being obvious over *Bresina et al.* in view of *Williams et al.* in view of *Lin*. The Examiner considered that the combination of *Bresina et al.* and *Williams et al.* elements of the claims did not teach bores having intersecting wall portions forming a communication path extending from the upper to the lower surface. The Examiner considered that FIG. 8 of *Lin* evidenced the use of bores having intersecting wall portions forming a communication path extending from the upper to the lower surface to secure the implant and promote bone growth. Thus, the Examiner considered that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of *Bresina/Williams*.

Even assuming *Lin* teaches bores with intersecting wall portions from the upper to lower surface the Examiner has not made any case relating to a suggestion or incentive to combine the teachings of *Lin* with *Bresina et al.* and *Williams et al.*. *Lin* has a pair of bores for receiving bone screws which screws extend entirely through the device and into either the adjacent upper and lower vertebra. There is no teaching or suggestion in *Lin* that the screws 200, 250 could be eliminated and replaced with bone growth inducing substances. The fact that the holes 121 of *Lin* are threaded further teaches away from their combination with *Bresina* and *Williams*. One of ordinary skill in the art would not look to the threaded bores of *Lin*, which are for the purpose of receiving bone screws, in designing the shape of bone graft receiving bores. There is no teaching or suggestion in *Lin* that the bores 121 could be utilized for bone graft.

The Examiner has the burden of showing that there is something in the prior art references to suggest the desirability and thus the obviousness of making the combination in a way that would produce the claimed structure. The use of bone screws for connecting the implant of *Lin* to the vertebra teaches away from the use of bone graft to perform the same function. The use of threaded, slanted holes having an 8-shaped outlet on the contact surface to accommodate slanted screws teaches away from *Lin's* combination with *Bresina et al.* and *Williams et al.* to make the separate bone graft bores of *Williams et al.*, which extend through the upper and lower surfaces, unified with the bores having intersecting wall portions making a communication path extending all the way from the upper to the lower implant surface.

Applicants do not believe the Examiner has made out a *prima facie* case of obviousness since there is no teaching or suggestion in the prior art combine *Lin* with the other prior art cited by the Examiner. The Examiner has the initial burden of providing some suggestion of the desirability of providing intersecting bores extending from the upper and lower surfaces for receiving bone graft material. Nothing in *Lin* at all suggests the complete elimination of the screws therein to form intersecting bores that could be used to receive bone graft. The Examiner has not made out any case as to why or how *Lin* could be used with bone graft. The Examiner merely indicates that FIG. 8 evidenced the use of bores having intersecting wall portions to promote bone growth. FIG. 8 teaches no such thing and primarily relates to the fixation bars 310 apparently to prevent the bone screws 250 from backing out after insertion. FIG. 8 has nothing to do with the use of bone graft and after insertion of bone screws 250 there is no communication path extending from the upper to the lower surface.

A combination of *Lin* with *Bresina et al.* and *Williams et al.* would merely result in an implant having a pair of bone screws 250 through for example bores 103 and 104 of *Williams et al.*

M.P.E.P. ¶ 2143.01 requires the Examiner to provide the suggestion or motivation for combining or modifying the teachings of the prior art to produce the claimed invention. In order to do this there must be some teaching suggestion or motivation for doing so either explicitly or implicitly in the references. *See In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

In summary, it is Applicants position that the teachings of *Lin* and its method of operation are so different from that of *Williams et al.* that there would be no incentive for one of ordinary skill in the art to make the combination set forth by the Examiner. Consequently, Applicant considers that the claims as previously filed patentably distinguish over the prior art cited by the Examiner.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

Application No.: 10/004,969

Docket No.: SPINE 3.0-2678

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: November 9, 2004

Respectfully submitted,

By 

Raymond W. Augustin

Registration No.: 28,588

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

(908) 654-5000

Attorney for Applicants